

REMARKS/ARGUMENTS

Claims 1 to 4, 6 to 8, 11 to 14, 16 and 18 to 24 are pending in the application.

35 U.S.C. § 103 Claim Rejections

Applicant understands that the Examiner has rejected all of the pending claims under 35 U.S.C. § 103(a) as obvious having regard to Noel et al. (Noel), U.S. Publication No. 2005/0032539 in view of Forssell et al. (Forssell) U.S. Patent No. 6,671,511. Applicant notes that paragraph 8 beginning at the top of page 4 of the Official Action makes reference to anticipation under 35 U.S.C. § 102(e). Applicant gratefully acknowledges the opportunity to discuss this case with the Examiner on September 19, 2008. In that conversation, the Examiner confirmed that the reference to 35 U.S.C. § 102(e) and anticipation in paragraph 8 is a typographical error and that paragraph 8 is directed to an obviousness objection under 35 U.S.C. § 103(a). The comments below are therefore limited to a response to the obviousness rejection.

The Examiner has rejected claims 1 to 3, 6 to 8, 11 to 14, 16 and 18 to 24 as obvious having regard to Noel et al. (Noel), U.S. Publication No. 2005/003259 in view of Forssell et al. (Forssell), U.S. Patent No. 6,671,511. Applicant respectfully traverses the rejection.

In rejecting claims under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d, 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. Additionally, in making a rejection under 35 U.S.C. § 103(a) on the basis of obviousness, the Examiner must provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR*

Int'l. Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the applicant. *See Oetiker*, 977 F.2d at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

Applicant's analysis below demonstrates that the Examiner has failed to fulfil the initial burden for a finding of obviousness under 35 U.S.C. 103.

Applicant submits that claims 1 to 3, 6 to 8, 11 to 14, 16 and 18 to 24 of the present application are patentable over Noel in view of Forssell as the Examiner has not properly determined the differences between the claimed invention and the prior art. Furthermore, the Examiner has not provided a valid explanation to support an obviousness rejection under 35 U.S.C. § 103. Applicant's reasoning is detailed below.

Differences between the claimed invention and the prior art

The following is a discussion of why the cited references do not disclose all the elements of the rejected claims. While it may be considered that "the mere existence of differences between prior art and an invention does not establish the invention's non-obviousness", Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one skilled in the art (Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR international Co. v. Teleflex Inc.*, published in Federal Register Vol. 72, No. 195, October 10, 2007). As such, if elements from a claim are not disclosed by the combination of cited references and no valid reasoning is provided why the missing elements would be obvious, this may provide a strong basis for why a claim should not be rejected based on obviousness.

The present application relates to communications in half-duplex voice communications systems. In such systems, during an active communication session, only one user device in the session may be designated as the transmitting or talking device at any point in time. While the talking device is in possession of the transmit channel (during a talk period), all the other devices

(listener's devices) in the active call session are in listener mode and cannot transmit voice until the transmitting device releases the talk/transmit channel.

The present invention provides a method, system and device for a listener's device in such a scenario to transmit a message, a transmit channel requests message, to the talker's device. The transmit channel requests message (TCRM) is sent over a logical control channel from the listening device to the transmitting device while the transmitting device is in possession of the transmit channel in the half-duplex session. The TCRM indicates that the transmit channel is requested. The TCRM also identifies the listener device which is requesting use of the transmit channel.

In this regard, claim 1 recites:

- a) "transmitting a transmit channel request message (TCRM) to a network;
- b) the TCRM indicating a request from the first user device to transmit on the transmit channel;
- c) the network forwarding the TCRM to a second user device... while the second user device is in a transmitting and half-duplex mode; and
- d) the TCRM including an identification of the first user device.

In other words, the message, which is sent from the listener's device which is requesting the transmit channel, is routed through the network and sent to the second user device. The message requests the use of the transmit channel and includes the identity of the listener's device making the request.

Noel does not include this limitation of claim 1. On page 2 of the Official Action, the Examiner notes that in Noel the call originator selects the participants and their identities are stored in the network. However, the identity of the user device is not part of the requesting message sent to the current speaker in Noel. There is no indication anywhere in Noel that the identity of the participant requesting the channel is forwarded to the current speaker. The

Examiner has said that “[t]he current speaker receives the request and has... access to the database storing the participant’s identity .” Even if this statement of the Examiner were correct, this is not the same thing as the requesting message sent to the current speaker including the identity of the participant wishing to speak. As described by the Examiner, the current speaker would have to access the identity of the requestor in the network. This would involve another message sent by the current speaker to the network and would not be part of the original requesting message sent to the current speaker.

Further, there is no indication anywhere in Noel that anyone other than the person who set up the call has access to the database storing the participant’s identity. Thus, the statement quoted above is not correct. Any current speaker who is not the call originator does not have the ability to access the database storing the participant’s identity.

The Examiner concedes that Noel does not specifically disclose a further limitation of claim 1, namely the transmit channel request message includes a qualifier flag at least when the transmit channel request message is forwarded to the second user device and the second user device performs extended functionality in response to the value of the qualifier flag. The Examiner points to Forssell et al. and in particular column 9, lines 11-44, as providing this limitation. However, the passage of Forssell referred to by the Examiner describes only communication between a mobile station and a network. It nowhere refers to a second user device. Thus, this limitation is not met by Forssell.

For at least the reasons discussed above, Applicant respectfully submits that the combination of Noel and Forssell does not teach all the limitations recited in claim 1. Furthermore, the Examiner has failed to explain why the missing limitations would be obvious to one skilled in the art. Without all the limitations of claim 1 being disclosed by the two references and no reason provided by the Examiner why these missing limitations would be obvious, Applicant submits that there are differences between what is recited in claim 1 and what is disclosed in the cited art that renders the claims not obvious.

Reason to Combine

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. An obviousness inquiry requires a review of a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. For the Patent Office to combine references in support of an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have combined the references *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, *slip op.* at 14 (U.S., Apr. 30, 2007), Id. at 15. Even if the Patent Office is able to articulate and support a suggestion to combine the references, it is impermissible to pick and choose elements from the prior art while using the application as a template.

Applicant submits that there is no suggestion of a desirability of the claimed invention in the references that would serve as a reason for one skilled in the art to combine the references. Noel teaches that the control of whether the call is handed over to a new speaker is based on information programmed in a central database. It is not based on the speaker being informed of the identity of the person wishing to speak, and making a decision on whether to allow that person to speak with the knowledge of their identity in hand.

The Examiner alleges that “[a]t the time of the invention, it would have been obvious to a person of ordinary skill in the art to transfer information (Forssell) allowing efficient and organized queuing of call participants (Noel)”. Even if what is disclosed in Forssell were to be considered equivalent to the specific limitation of claim 1 to which it is being equated, which Applicant does not concede, Applicant submits that without a suitable reason, the combination of references is improper. There is no reason to combine Forssell with Noel. Forssell is concerned with the problem of how to transfer delay sensitive data in a pocket radio service. This is unrelated to the problem of Noel of how a call originator can control who speaks in a half-duplex call.

In addition, the Examiner's motivation for combining Forssell and Noel is tied to a view that Noel and Forssell teach these limitations. As detailed above, this is an incorrect interpretation of the references and as such this also affects the Examiner's reason for combining the cited references.

For at least the reasons above, Applicant respectfully submits that the combination of Noel and Forssell do not teach all the limitations recited in claim 1. Furthermore, the Examiner has failed to explain why the missing limitations would be obvious to one skilled in the art. Without all the limitations of claim 1 being disclosed by the two references and no reason provided by the Examiner why these missing limitations would be obvious, it is not reasonable to expect one skilled in the art to arrive to the claimed invention based on the cited references.

Claims 2 to 4, 6 to 8 and 11 depend from claim 1, either directly or indirectly. Device claim 12, network claim 21 and memory claim 24 are independent claims that recite limitations that are substantially the same as claim 1. Claims 13, 14, 16 and 18 to 20 depend directly or indirectly from device claim 12, 22 and 23.

For at least the reasons discussed above concerning claim 1, Applicant submits that claims 2 to 4, 6 to 8, 11 to 14, 16 and 18 to 24 patentably distinguish over Noel and Forssell.

The Examiner has rejected claim 4 under 35 U.S.C. 103(a) as being unpatentable over Noel in view of Stubbs, U.S. Patent No. 6,930,994.

The Examiner points to Stubbs as teaching wherein the half-duplex session is a voice communication session compliant with at least one system selected from the group of iDEN.TM., 1XRTT CDMA, GSM/GPRS, UMTS, and TDMA. Claim 4 depends from claim 1. Even if Stubbs teaches what is alleged by the Examiner, Stubbs does not overcome the deficiencies of Noel outlined above concerning claim 1. Accordingly, the combination of Noel of Stubbs does not render claim 4 obvious.

In view of the foregoing, early favorable consideration of this application is earnestly solicited. In the event that the Examiner has concerns regarding the present response, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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